

**REMARKS**

Applicants note with appreciation that the Examiner has entered Applicants' previous submission, and that the previous objections and rejections have been withdrawn.

Claims 71-80, 82-84 and 86-94 are currently pending in the application. The Examiner has raised several new objections and rejections. For clarity, these are listed below in the order in which they are addressed herein.

- I. Claim 90 is objected to as allegedly being grammatically incorrect.
- II. Claims 71, 72, 80, 82, 83, 86, 89, 90, and 93 are rejected under the judicially created doctrine of double patenting as being unpatentable over U.S. Patent No. 5,091,142.
- III. Claims 73-79, 84, 87, 88, 91, 92, and 94 are objected to as being dependent upon a rejected base claim.

  

- I. Claim 90 is objected to as allegedly being grammatically incorrect in reciting "said portion said third oligonucleotide . . .". Without acquiescing to the Examiner's arguments and reserving the right to prosecute the same or a similar claim in the future, Applicant's have amended Claim 90 to recite "said portion of said third oligonucleotide . . .". The amendment to the claim made herein does not narrow the scope of the claims within the meaning of *Festo*<sup>1</sup> or related cases. Applicants respectfully request that this objection be withdrawn.
- II. Claims 71, 72, 80, 82, 83, 86, 89, 90, and 93 are rejected under the judicially created doctrine of double patenting as being unpatentable over U.S. Patent No. 5,091,142. As this patent and the present application are co-owned by the present Applicants, Applicants herein file a terminal disclaimer to overcome the rejections. Applicants respectfully request that these rejections be withdrawn.

---

<sup>1</sup> *Festo Corp. v. Shokestu Kinzoku Kogyo Kabushiki Co.*, 122 S. Ct. 1831 (2002)

**III.** Claims 73-79, 84, 87, 88, 91, 92, and 94 are objected to as being dependent upon a rejected base claim. Applicants have addressed the sole basis for rejection of the base claims by the filing of a terminal disclaimer herewith. Removal of the obviousness-type double patent rejections renders these objections moot and Applicants respectfully request that these objections be withdrawn.

### **CONCLUSION**

For the reasons set forth above, it is respectfully submitted that Applicants have addressed all objections and rejections, and Applicants' claims should be passed to allowance. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, Applicants encourages the Examiner to call the undersigned collect at (608) 218-6900.

Dated: January 28, 2005

  
Mary Ann D. Brow  
Mary Ann D. Brow  
Registration No. 42,363  
MEDLEN & CARROLL, LLP  
101 Howard Street, Suite 350  
San Francisco, California 94105  
(608) 218-6900